

ATTORNEY DOCKET NO.
NORTH 685000

PATENT APPLICATION
SERIAL NO. 09/065,787

service provider means including means for storing a data network recipient's e-mail address received from a calling party address and a voice network originated message for that recipient;

voice network means for inputting a recipient e-mail address to be stored in said service provider;

voice network means for supplying a message to be stored in said service provider; and means for converting the supplied message to a format appropriate for transmission over a data network.

REMARKS

The Final Action dated July 31, 2002 in this application has been carefully considered and the above amendment and following remarks are presented in a sincere attempt to place this application in condition for allowance. By this amendment, Claim 13 has been amended.

Reconsideration and allowance is respectfully requested in light of the foregoing amendment and the following remarks.

Rejection of Claim 13 Under 35 U.S.C. 112, Second Paragraph

The Examiner has rejected Claim 13 under 35 U.S.C. 112, second paragraph, on the grounds that it ends with a method step. In response, Applicants have amended the last paragraph of Claim 13 to recite "means for converting the supplied message to a format appropriate for transmission over a data network." In view of this amendment, it is respectfully submitted that the rejection of Claim 13 under 35 U.S.C. 112, second paragraph, has been overcome.

Rejection of Claims Under 35 U.S.C. 103(a)

1. Claims 1, 6, 11-13, 15-18, 20-22, 30, 31, 33, 35, 36, 39 and 42

The Examiner has rejected Claims 1, 6, 11-13, 15-18, 20-22, 30, 31, 33, 35, 36, 39 and 42, Claims 1, 13, 17, 20, 22 and 30 of which are independent, under 35 U.S.C. 103(a) as being assertedly unpatentable over United States Patent No. 6,014,711 (Brown) in view of United States Patent No. 5,717,742 (Hyde-Thomson). In particular, the Examiner contends that Brown discloses all the elements of each of these claims with the exception of its failure to disclose the limitation requiring inputting a recipient e-mail address received from a calling party. Instead, Brown discloses sending an information message over the Internet to an unknown address of a recipient by inputting a telephone number of the recipient. (Brown, Abstract; col. 2, lines 56-61).

The Examiner contends Hyde-Thomson teaches a message handling system in which a voice-originated message is converted to a digital voice file, which is stored in a shared memory device corresponding to the intended recipient's mailbox, using standard e-mail software. A voice gateway PC records and digitizes the user's voice message, and attaches the digitized voice file to a text e-mail file. The Examiner contends that it would have been obvious to one of ordinary skill in the art to modify the invention of Brown so that the e-mail address is known by the sender, because e-mail addresses are oftentimes easy for users to remember, and specifying the e-mail address by the user would reduce network traffic.

The rejection of these claims is respectfully traversed. As the Examiner recognizes, Brown teaches inputting a telephone number rather than the e-mail address itself as an assertedly "unique identifier" for the e-mail recipient. However, to do what Brown teaches requires that the calling party know the unique telephone number of the intended recipient. To do what Hyde-Thomson teaches requires a table associating the telephone number with the desired e-mail address. It then further requires that the system take the additional step of looking up the entered telephone number and translating it to a desired e-mail. In Brown, these steps are apparently considered justified by the convenience of entering a purely numerical telephone number on a telephone keypad.

A critical difficulty with the approach taught in Brown, however, which the Examiner has not considered, is that there often is no unique association between a particular telephone number and a particular desired e-mail address, because a person frequently has multiple telephone numbers and multiple e-mail addresses that are used at different times or under different circumstances. Even in the circumstances where there is a unique telephone number to e-mail correspondence, each telephone number/e-mail address pair must first be entered into the table for the system taught by Brown to work. Brown provides no solution to the problem of what to do when there is no unique association between the telephone number and the desired e-mail address, or where the telephone number/e-mail address pair has not yet been entered into the table. Hyde-Thomson provides no solution, because it either requires the calling party to have access to a computer and e-mail program, or to know the voice mailbox number of the recipient, which is not always the case.

In the present invention, the disadvantages of Brown, even if hypothetically modified by Hyde-Thomson, are eliminated. By permitting the direct entry of the desired e-mail address (albeit into a telephone), as in the present invention, the calling party knows where the e-mail including the voice-originated message will be delivered without ambiguity. There also is no need for the calling party to know the recipient's voice mailbox number in order to send a voice-originated message. Importantly, in the present invention, as contrasted to Brown and the other prior art of record, the recipient does not even need to have a telephone number, or even a telephone in order to receive a voice-originated message. By contrast, with Brown, if the intended recipient does not have a telephone number, it is simply impossible to send a voice-originated message. With Hyde-Thomson, it is impossible for the caller to leave a voice message without either access to a computer and e-mail program or knowledge of the recipient's voice mailbox telephone number. The present invention, however, permits leaving a recipient a voice-mail message without the calling party having a computer and without knowing the recipient's telephone number. These features particularly make possible pay-per-use telephone service, for example, where neither the caller nor the intended recipient need to do anything in advance, such as buying equipment, inputting a list of telephone numbers and e-mails, etc.

It is respectfully submitted that the Examiner is also failing to consider important factors that would cause a person skilled in the art to believe that entering an e-mail address directly was impossible, impractical or undesirable, tending to show nonobviousness. In particular, e-mail addresses are often longer than telephone numbers and include alphabetic and other characters. Thus, e-mail addresses would be considered by a person skilled in the art as impractical to enter on a numerical telephone keypad than pure numbers, whether theoretically possible or not. This fact would tend to cause a person skilled in the art to look elsewhere than Hyde-Thomson (where the e-mail address could presumably be entered using a conventional alphanumeric keyboard) for solutions to the shortcomings of Brown. Furthermore, the fact that direct entry of the e-mail address overcomes so many shortcomings of Brown, Hyde-Thomson and the other prior art of record, tends to show important needs met by the present invention that have long eluded the art, tending to show nonobviousness.

For the foregoing reasons, it is respectfully submitted that the invention defined by Claims 1, 6, 11-13, 15-18, 20-22, 30, 31, 33, 35, 36, 39 and 42 would not have been obvious and are in condition for allowance. Withdrawal of the final rejection of these claims is believed in order and is courteously requested.

2. Claims 2-5, 7-10, 12, 14, 16, 19, 23-29, 32, 34, 37-38 and 40-41.

The Examiner has rejected Claims 2-5, 7-10, 12, 14, 16, 19, 23-29, 32, 34, 37-38 and 40-41, of which Claim 30 is independent, under 35 U.S.C. 103(a) as being assertedly unpatentable over Brown and Hyde-Thomson as applied to Claims 1, 6, 13, 17 and 30 above, and further in view of various combinations of various isolated disclosures of United States Patent No. 6,219,413 (Burg), United States Patent No. 5,353,331 (Emery et al.), United States Patent No. 5,684,862 (Finnigan) and the asserted Admitted Prior Art.

Despite the additional disclosures of Burg, Emery et al., Finnigan and the Admitted Prior Art referred to by the Examiner, none of these references disclose the calling party inputting an e-mail address of the intended recipient of the voice-originated e-mail message, a limitation included in all the claims of the present application, including Claims 2-5, 7-10, 12, 14, 16, 19, 23-29, 32, 34, 37-38 and 40-41. Accordingly, for the reasons stated above with respect to

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Claims 1, 6, 11-13, 15-17-18, 20, 21, 22, 30, 31, 33, 35, 36, 39 and 42, it is respectfully submitted that Claims 2-5, 7-10, 12, 14, 16, 19, 23-29, 32, 34, 37-38 and 40-41 would also not have been obvious and are in condition for allowance.

Since all claims are now in condition for allowance, it is respectfully submitted that the Final Rejection be withdrawn and a Notice of Allowance be issued for all pending Claims 1-42, and such is courteously requested.

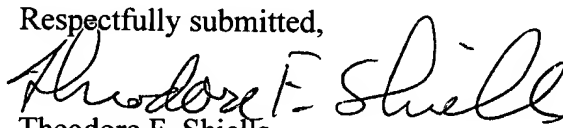
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Should the Examiner have any questions or desire clarification of any sort, or deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Dated:

9/30/02

Respectfully submitted,



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MARKED-UP VERSION OF CLAIM 13 SHOWING CHANGES MADE

13. (Twice Amended) Apparatus for automating the delivery of a voice network originated voice message to a data network recipient comprising:

service provider means including means for storing a data network recipient's e-mail address received from a calling party address and a voice network originated message for that recipient;

voice network means for inputting a recipient e-mail address to be stored in said service provider;

voice network means for supplying a message to be stored in said service provider; and

means for converting the supplied message to a format appropriate for transmission over a data network.